

REMARKS

The present application has been reviewed in light of the Office Action mailed November 14, 2006. Reconsideration of the present application is respectfully requested in view of the following remarks.

Election/Restriction

As per applicants' election, without traverse, of specie #1, sub specie A and sub-2specie II, applicant has withdrawn Claims 3-9, 11-16, 18 and 23-27 from further consideration.

Claim Rejection – 35 USC § 102

The Examiner has rejected to Claims 1, 10 and 19, under 35 U.S.C. 102(b), as being anticipated by Adams (USPN 4,127,222). Applicant has amended Claims 1 and 19 to better distinguish applicants' present disclosure from Adams. In particular, applicant has amended Claims 1 and 19 so that these claims now recite " [a]n electrosurgical instrument comprising...a selectively engageable over shoe adapted to engage the electrically conductive surface..." The dependent claims have also been amended to correspond to their respective independent claims.

According to § 2131 of the MPEP, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Adams discloses a thimble used for sewing and there is no mention of

employing Adams for any other purpose such as utilizing as an electrosurgical instrument. Because Adams does not teach or suggest each and every element of the applicants' disclosure, the 102(b) rejection should be withdrawn and Claims 1 and 19, and any claims depending therefrom, should now be in condition for allowance.

The Examiner has rejected Claim 19 under 35 U.S.C. 102(b), as being anticipated by Tetzlaff et al., (USPN 6,277,117 B1). Applicant respectfully submits that this rejection should also be withdrawn. It is respectfully submitted that Tetzlaff et al. is distinguishable for many reasons. For example:

a) In Tetzlaff et al., an electrode assembly is snapped into place over a pivot of the forceps to engage an inwardly disposed face of each respective jaw member. A series of outwardly projecting detents, e.g., 124 and 122, engage a corresponding series of apertures, e.g., 44 and 41, disposed in the jaw members, e.g., jaw member 120. The energy is applied through the sealing surfaces 126 that engage the tissue.

In contrast, applicants' invention relates to an overshoe that is selectively placed over the electrically conductive surface of the forceps. Energy is applied to the electrically conductive surfaces and travels through a series of apertures disposed in the overshoe to treat the tissue. As a result, the tissue is treated through the overshoe as defined by the particular configuration of the overshoe. This is clearly not the case with Tetzlaff et al. In fact, the aperture the Examiner is referring to lies along the edge of the seal surface and substrate interface and is, as the Examiner points out, a lip. This is certainly not an aperture that provides a path for electrosurgical energy to treat tissue during activation;

b) In Tetzlaff et al., apertures 41 and 44, e.g., are disposed in the housing portion of each jaw member and align and engage a series of detents or mechanical interfaces, e.g., detents 122, 124, disposed on the outer facing surface of each electrode of the electrode assembly. During assembly, the substrate 121 is overmolded to capture the electrically conductive surface 126. There is clearly no mention of apertures being disposed through the electrically conductive face plate of the electrode assembly and, even if this was the case, applicants' invention is certainly distinguishable since the seal surface of Tetzlaff et al. is the conductive seal surface 126 and not a non-conductive tissue wall as presently claimed; and

c) In Tetzlaff et al., the seal surfaces are designed to engage both jaw members in a simultaneous fashion. In contrast, since the over shoe is not conductive, the surgeon can overlay a conductive surface of one jaw member, if desired, and still operate the instrument in its intended fashion. Tetzlaff would not operate properly if configured in this fashion. This also allows the physician to select an overshoe with different aperture configurations so that different surgical purposes may be achieved, for example, cutting, coagulating, sealing, dissecting, and blending.

Thus, based on the above arguments, it is evident that Claim 19, as amended, is clearly patentably distinguishable from the Tetzlaff et al. disclosure. Therefore, it is respectfully submitted that the rejection of Claim 19 and any claims depending therefrom should be withdrawn.

Claim Rejection – 35 USC § 103

The Examiner has rejected Claim 2 under 35 U.S.C. 103(a) as being unpatentable over Miller (USPN 6,726,068). Applicants respectfully traverse this rejection. Applicants have amended independent Claim 1, which Claim 2 directly depends. Claim 1 now recites "[a]n electrosurgical instrument comprising...a selectively engageable over shoe adapted to engage the electrically conductive surface..." This is neither taught nor suggested by Miller. In order to overcome a 35 USC § 103(a) rejection applicant can show that each and every limitation is not taught or suggested by the reference cited. Therefore, based on the amendment to Claim 1 noted above, Claim 2 and any claim depending therefrom should now be in condition for allowance.

In addition, it is respectfully submitted that the 35 USC § 103(a) rejection should be withdrawn as being directed toward non-analogous art. According to the MPEP, § 2141.01(a), in order to rely on reference under 35 U.S.C. 103, it must be analogous prior art. "A prior art reference must be in the field of the applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, *In Re Oetiker* 24 USPQ2d 1443, 1445 (*Fed. Cir.* 1992)." Neither is present.

The Miller reference, cited by the Examiner, is non-analogous art because it is not in the applicants' field of endeavor and it is in no way reasonably pertinent to the particular problem with which the applicant was concerned. The Miller disclosure relates generally to fingertip protectors and thimbles that are designed for enhanced comfort, and that allow for better control of a sewing needle. More particularly, Miller teaches of an elastomeric material that is placed over a fingertip. Applicants' present disclosure relates

to electrosurgical instruments used for sealing tissue. More particularly, the present disclosure relates to an overshoe for use in cooperation with electrosurgical instruments for controlling the amount of electrosurgical energy delivered to a tissue, which is configured to overlie an electrically conductive surface.

In addition, as mentioned above, the Miller reference is not reasonably pertinent with that which the applicants are reasonably concerned. The subject matter disclosed in Miller is not pertinent to the particular problem with which the applicants are involved. Miller is concerned with protecting tissue while sewing fabric and the like. Applicants' present disclosure concerns sealing and/or cutting tissue during a surgical procedure. It is respectfully submitted that a sewing thimble would in no way solve the problem being addressed with applicants' claimed invention.

Moreover, the Miller disclosure does not have any relevancy that would have been particularly important to the applicants' concerns. There are no logical and/or practical reasons that would have commanded applicants' attention, in considering applicants' problem, in the subject matter in which the Miller disclosure relates. This becomes evident, for example, in the ceramics implemented in both disclosures. In Miller, a ceramic material was used because it protected a user's fingertips from the sharp tip of a needle, whereas, in the present disclosure, a ceramic material was used because of its non-conductive nature. From the foregoing, it is clearly evident that a person of ordinary skill in the art would not reasonably have expected to solve the problems of controlling and/or limiting the current (or current per arc on a micro level) and controlling the degree of tissue heating and the degree of tissue vaporization during an electrosurgical procedure by

considering a reference dealing with ceramic thimbles. Therefore, the Miller reference cannot be considered reasonably pertinent to the problem of the applicants' concern.

Further, there are no structural similarities between the thimble, in the Miller disclosure, and the overshoe, in the applicants' disclosure. For example, there are no common interfaces and/or members present in the applicants' disclosure and the Miller reference. In the applicants' disclosure there are a multitude of different members that are being operated simultaneously to perform the needed sealing and/or cutting. In Miller, a user simply places their fingertip inside an opening of the thimble. Thus, it is clear that the arts to which the Miller patent belongs is not reasonably pertinent to the arts with which applicants' disclosure belongs.

In the event that the Examiner does not find applicants' arguments persuasive, applicant, as mentioned above, has amended Claim 1 of the present disclosure to more clearly distinguish applicants' disclosure from this above cited prior art reference. In view of the arguments above and the amendment to Claim 1, it is requested that the Examiner reconsider the rejection of Claim 2.

The Examiner has also rejected Claim 17 under 35 U.S.C. 103(a) as being unpatentable over Adams (USPN 4,127,222). For the same or similar arguments as mentioned above, it is respectfully requested that this rejection also be reconsidered by the Examiner as being non-analogous.

Regarding new Claims 28-31, applicants have added these claims to better distinguish applicants' disclosure from the above cited prior art. In particular, these claims recite an over shoe with a plurality of aligned apertures, wherein the apertures are

configured based on a particular surgical purpose, the surgical purpose being selected from the group consisting of cutting, coagulating, sealing, dissecting, and blending.. Support for these claims can be found in the disclosure, more specifically, pages 17-21 and FIGS. 12-15.

CONCLUSION

In view of the foregoing amendments and remarks, reconsideration of the application and allowance of all pending claims is earnestly solicited.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicants' undersigned representative at the number indicated below.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted.



Thomas A. Beaton
Reg. No. 46,543
Attorney for Applicants

Date: 1/6/07

UNITED STATES SURGICAL

A DIVISION OF TYCO HEALTHCARE GROUP LP
195 McDermott Road
North Haven, CT 06473
(303) 581-6831